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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

In re Patent Application of
WHITEHEAD
Serial No. 09/863,010
Filed: May 23, 2001
Title: SERVICE SUBSCRIPTION SERVICE BUSINESS

Atty Dkt. 3813-3
C# M#
TC/A.U.: 3625
Examiner: Y. Garg
Date: January 3, 2006

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

☐ Correspondence Address Indication Form Attached.

☐ **NOTICE OF APPEAL**

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences
from the last decision of the Examiner twice/finally rejecting applicant's claim(s).

\$500.00 (1401)/\$250.00 (2401) \$

☒ An appeal **BRIEF** is attached in the pending appeal of the
above-identified application

\$500.00 (1402)/\$250.00 (2402) \$ 250.00

☐ Credit for fees paid in prior appeal without decision on merits

-\$ ()

☐ A reply brief is attached.

(no fee)

☐ Petition is hereby made to extend the current due date so as to cover the filing date of this
paper and attachment(s)

One Month Extension \$120.00 (1251)/\$60.00 (2251)
Two Month Extensions \$450.00 (1252)/\$225.00 (2252)
Three Month Extensions \$1020.00 (1253)/\$510.00 (2253)
Four Month Extensions \$1590.00 (1254)/\$795.00 (2254) \$

☐ "Small entity" statement attached.

Less month extension previously paid on

-\$ ()

TOTAL FEE ENCLOSED \$ 250.00

Any future submission requiring an extension of time is hereby stated to include a petition for such time extension.
The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or
asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this
firm) to our **Account No. 14-1140**. A duplicate copy of this sheet is attached.

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By Atty: Alan M. Kagen, Reg. No. 36,178

Signature: Alan M. Kagen

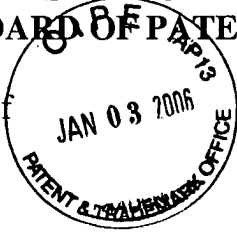
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APPEAL BRIEF

Sir:

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences from
the last decision of the Examiner.

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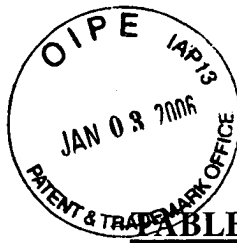


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(I) **REAL PARTY IN INTEREST**

The real party in interest is Clay T. Whitehead.

(II) RELATED APPEALS AND INTERFERENCES

The Appellant and the undersigned are not aware of any related appeals, interferences, or judicial proceedings (past or present), which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

(III) STATUS OF CLAIMS

Claims 1-22 are pending and have been rejected. Claims 6, 10, 11, 13 and 17 have been withdrawn from consideration. No claims have been substantively allowed.

(IV) STATUS OF AMENDMENTS

No amendments have been filed since the date of the Final Rejection.

(V) SUMMARY OF CLAIMED SUBJECT MATTER

The invention relates to a method and system of administering consumer items including regularly purchased items or subscription items over a global network.

The system and method provide a service to individuals and businesses that finds and, at the customer's option, automatically subscribes them to a lowest-cost provider for subscription-type consumer items such as but not limited to telephone, long distance, cellular phone, electricity, gas, home insurance, car insurance, cable TV, Internet access, magazine subscriptions, mortgages, travel, etc. See paragraph [0004].

Exemplary applications of the system are described in paragraph [0005].

The system maintains and continuously updates a database of services and prices and transaction costs, regularly monitors a customer's usage of each product or service, finds the lowest prices available to each customer for each product or service, and then switches the customer's account at the customer's option to the chosen service provider. Where multiple pricing plans are available from a single provider, the system analyzes the customer's pattern of use to determine which provider and pricing plan is most economic. The system can be offered directly to customers via Internet, mail and/or telephone and may also provide the functionality to other companies so that they can co-brand or private label the service. See paragraph [0006].

The system may provide the customer with the option of specifying criteria other than price in a user profile and selects the lowest-cost consumer items meeting those criteria. The system also gives the customer the option of consolidating billing for all services into a single bill. See paragraph [0007].

The system performs comparative shopping for a customer, while continually repeating the comparison to provide a menu of choices, identifying the lowest-cost option meeting the customer's requirements, automatically switching the customer's service to whichever service provider affords the best price, optionally consolidating billing for all services into a single bill, etc. See paragraph [0009].

Figure 1 is a flow diagram of the basic procedure and system of the invention. The customer accesses the system via a system homepage including a service and account interface 10, where the customer controls all decisions and information displays. The customer can select services, see options for each service from vendors, select options, choose options individually or select the automatic best choice (ABC) service, wherein relevant consumer items identified by the system according to the user profile are automatically implemented. See paragraph [0029].

The system monitors the customer's usage of each consumer item and periodically re-optimizes according to usage patterns at a monitoring and notification location 14. Vendors are notified of service changes requested by the customer or implemented by the ABC service. The customer may choose to be billed by the vendor 16 or to have bills consolidated and be billed by the billing system 18 of the service subscription service or some other billing service. See paragraph [0030].

The service choices function 20 is shown in more detail in Fig. 2. For each service selected at 22, the customer can see vendor service and pricing options 24, supply initial information to suggest a best service plan 26, select the vendor and bundling and pricing plan for each service 28, or select the ABC service. An optimizer 34 shows the customer

which vendors and which plans provide the lowest cost for the service and usage parameters supplied by the customer and/or monitored by the system. Options for improvement 36 (Fig. 1) are automatically implemented if the customer has chosen the automatic best choice service. Non-ABC customers are notified of options for improvement via the account interface, e-mail and/or other means. See paragraph [0031].

The optimizer function in Figs. 1 and 2 is shown in more detail in Fig. 3. The optimizer 34 takes into account all information that could affect the cost and quality of service for each service. Data from vendors, regulatory authorities, and other sources 44 is compared with the customer information to determine which services, bundles, pricing plans and other service features are eligible for meeting the customer needs 46. From this data, a least-cost package is determined at 48, consistent with any specification of vendor or service made by the customer. See paragraph [0032].

Referring to Fig. 4, the system regularly monitors customer usage patterns via 52 and changes in services and pricing from the vendors via 54. The optimizer 34 obtains improvement options 56 and determines whether any changes would lower the cost of the service 58. If the ABC option is chosen by the customer, the service packages are automatically implemented, and the vendors are notified 60. Otherwise, the customer is notified 62 and provided with an opportunity to selectively implement identified relevant items. See paragraph [0033].

With this method and system of the invention, customers can be comforted that they are getting subscription services and the like according to their personal user profile at a lowest available cost. Of course, the system can also be used on a one-time basis to

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enable a customer to purchase one-time products and services according to predefined criteria. The system is easy to use and maintain, and with the ABC service option selected, customers can be assured that they are automatically getting desired products and services at a best available cost. See paragraph [0034].

(VI) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-5, 7-9, 12, 14-16 and 18-22 are unpatentable under 35 U.S.C.
§102(e) over U.S. Patent Publication 2001/0014868 to Herz et al.

(VII) ARGUMENT

The system described in the Herz publication is a seller-driven system that endeavors to identify product pricing or offers to maximize profits based on a profile of the target shopper. An important distinction between the present invention and the Herz publication is that the present invention is rather a buyer-driven system that seeks suitable products and services for a particular user based on a user profile. As described in the specification, in a preferred application, the user profile is defined by or for that system user.

The Office Action misunderstands this point, noting that “the features upon which applicant relies (i.e., that his invention is not a seller driven and Herz’s invention is a seller driven) are not recited in the rejected claim(s).” Applicant does not contend that the claims “expressly” define a buyer-driven method/system; rather, the claims define a method/system that utilizes a user profile relating to desired consumer items, and thus the administration is effected from a buyer’s perspective. Moreover, if the automatic best choice service is incorporated in the user profile, the relevant items are automatically implemented. Since the Herz system is in contrast a seller-driven system, Herz could in no way incorporate an automatic best choice service. Applicant thus respectfully submits that Herz lacks at least step (c) of claim 1, step (d) of claim 14, and related subject matter defined in claims 21 and 22.

As recognized in the Office Action, at best, the Herz system identifies and makes offers suitable to particular shoppers. Nowhere does the Herz system even remotely appreciate a potential application where one or more of those offers is automatically

accepted. In this context, the Office Action provides that “[i]nforming the shopper automatically of the best offers based upon his profile and the offers stored in a database reads upon the recited limitation.” Applicant respectfully submits, however, that this statement is entirely inaccurate. Indeed, such a conclusion is akin to a scenario where a shopper asks for advice from a vendor, and the vendor provides product suggestions. Using the Examiner’s logic, the vendor’s suggestions are equivalent to an automatic purchase by the shopper. Clearly, such logic is misplaced.

In the “Response to Arguments” section in the Final Office Action dated August 16, 2005, the Office Action contends that a feature of the invention where one or more offers is automatically accepted is not recited in the claims. To the contrary, however, independent claim 1 defines in step (c), “if the user profile incorporates an automatic best choice service, automatically implementing the relevant items, and communicating the implemented relevant items to the user.” Emphasis added. A similar feature is included in independent claims 14, 21 and 22. As noted, the automatic best choice service of the invention is an important feature enabling the relevant items to be automatically implemented (i.e., the best offer(s) for that particular user is automatically accepted). In each instance in the Herz patent, in contrast, the shopper must make a decision to accept an offer. Additionally, a determination of a “best” offer will likely be different depending on from whose perspective, i.e., buyer or seller, it is viewed. Thus, the presentation of “best offers” in the Herz system may not even identify the offer that would be automatically accepted with the automatic best choice service defined in the present application claims.

For at least these reasons, Applicant thus respectfully submits that the rejection is misplaced.

With regard to the dependent claims, Applicant submits that these claims are allowable at least by virtue of their dependency on an allowable independent claim. Moreover, claim 3 recites that step (a) is practiced according to user-entered parameters. The Office Action references the Herz system tracking the behavior of shoppers. Such tracking, which is the nature of a seller-driven system, does not in any manner meet the feature of the invention where a user profile is compiled according to user-entered parameters.

Claim 4 defines a step of periodically repeating steps (b)-(d). Claim 15 defines related subject matter. The Office Action references seasonal buying for certain groups of shoppers, which again is a parameter of a seller-driven system. In the present invention, periodically repeating the consumer item administration regularly ensures the user that he/she has implemented the best products and services according to their particular user profile.

Reversal of the rejection of allowance of the application are respectfully requested.

In a discussion with Examiner Garg on December 22, 2005, Applicant's representative inquired about whether the use of "if the user profile . . ." in the claims is somehow the reason the Examiner is reaching the clearly inaccurate conclusion as discussed above. Applicant's representative proposed to amend the claim language to specify that the user is provided an "option" to incorporate the automatic best choice service. Examiner Garg, however, was unable to assist at this time.

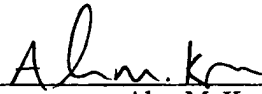
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CONCLUSION

It is believed that the application is in clear condition for allowance; therefore, early reversal of the Final Rejection and passage of the subject application to issue are earnestly solicited.

Respectfully submitted,

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(VIII) CLAIMS APPENDIX

1. A method of administering consumer items over a global network, the method comprising:
 - (a) compiling a user profile relating to desired consumer items;
 - (b) accessing a database of items available from product and service providers, and identifying relevant items according to the user profile;
 - (c) if the user profile incorporates an automatic best choice service, automatically implementing the relevant items, and communicating the implemented relevant items to the user; and
 - (d) if the user profile does not incorporate the automatic best choice service, communicating the relevant items to the user, and enabling the user to selectively implement the relevant items.
2. A method according to claim 1, wherein step (a) is practiced by monitoring a pattern of consumer item use.
3. A method according to claim 2, wherein step (a) is further practiced according to user-entered parameters.
4. A method according to claim 1, further comprising periodically repeating steps (b)-(d).
5. A method according to claim 1, wherein in step (b), the relevant items are identified based on a lowest cost consistent with the user profile.
6. A method according to claim 1, further comprising consolidating billing for the implemented relevant items according to steps (c) and (d).
7. A method according to claim 1, wherein the communicating in steps (c) and (d) are performed via electronic mail.
8. A method according to claim 1, wherein the consumer items comprise subscription services.
9. A method according to claim 1, practiced on a one-time basis to effect a purchase of a particular product.
10. A method according to claim 1, practiced to effect a change of service from one vendor to another.
11. A method according to claim 1, practiced to effect a sale of one product and purchase of a replacement product.

12. A method according to claim 1, wherein step (c) is practiced by identifying related items separately and in combinations that are available at low incremental cost, and communicating the identified related items to the user.

13. A method according to claim 1, further comprising informing the user if one or more parameters in the user profile significantly affects costs.

14. A method of obtaining and maintaining consumer items including products and services at a lowest available cost over a global network, the method comprising:

(a) compiling a user profile according to a pattern of customer use and user-entered parameters;

(b) maintaining a database of items available from product and service providers;

(c) accessing the database of items and identifying relevant items according to the user profile;

(d) if the user profile incorporates an automatic best choice service, automatically implementing the relevant items, and communicating the implemented relevant items to the user; and

(e) if the user profile does not incorporate the automatic best choice service, communicating the relevant items to the user, and enabling the user to selectively implement the relevant items.

15. A method according to claim 14, further comprising periodically repeating steps (b)-(e).

16. A method according to claim 14, wherein in step (c), the relevant items are identified based on a lowest cost consistent with the user profile.

17. A method according to claim 14, further comprising consolidating billing for the implemented relevant items according to steps (d) and (e).

18. A method according to claim 14, wherein the communicating in steps (d) and (e) are performed via electronic mail.

19. A method according to claim 14, wherein the consumer items comprise subscription services.

20. A method according to claim 14, practiced on a one-time basis to effect a purchase of a particular product.

21. A computer system for administering consumer items, the computer system comprising:

at least one user computer running a computer program that compiles a user profile relating to desired consumer items and accesses a database of items available from product and service providers, the computer program identifying relevant items according to the user profile; and

a system server running a server program, the at least one user computer and the system server being interconnected by a computer network, the system server maintaining at least a portion of the database of available items and effecting implementing of the relevant items according to user preferences,

wherein if the user profile incorporates an automatic best choice service, the computer program automatically implementing the relevant items, and communicating the implemented relevant items to the user, and

wherein if the user profile does not incorporate the automatic best choice service, the computer program communicating the relevant items to the user, and enabling the user to selectively implement the relevant items.

22. A computer program embodied on a computer-readable medium for administering consumer items, the computer program comprising:

means for compiling a user profile relating to desired consumer items;

means for accessing a database of items available from product and service providers, and for identifying relevant items according to the user profile;

if the user profile incorporates an automatic best choice service, means for automatically implementing the relevant items, and for communicating the implemented relevant items to the user; and

if the user profile does not incorporate the automatic best choice service, means for communicating the relevant items to the user, and for enabling the user to selectively implement the relevant items.

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(IX) EVIDENCE APPENDIX

(NOT APPLICABLE)

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(X) **RELATED PROCEEDINGS APPENDIX**

(NOT APPLICABLE)